



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Graczyk et al.**

Application No: **10/509,127**

Group Art Unit: **1625**

Filed: **September 28, 2004**

Examiner: **Robert J. Balls**

For: **AZAINDOLES AS INHIBITORS OF C-JUN N-TERMINAL KINASES**

Attorney Docket No: **102286.152US1**

Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

CERTIFICATION UNDER 37 CFR § 1.8(a)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

09/06/06

Date of Signature & Mailing

Gerri Bellavia

Gerri Bellavia

**Response to Restriction Requirement and
Request for Reconsideration of Restriction Requirement Under 37 C.F.R. § 1.143**

I. Introductory Comments

This response is submitted in reply to the Restriction Requirement dated June 6, 2006, for which a response is due on or before September 6, 2006, with a two-month extension of time. Applicants petition for a two-month extension of time to respond to the outstanding Restriction Requirement.

Other than the fees related to the two-month extension of time, no other fees are believed to be due in connection with this filing. However, the Commissioner is authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 08-0219 to maintain the pendency of the present application.

II. Request for Reconsideration of Restriction Requirement

Under 37 C.F.R. §1.143, Applicants respectfully traverse the restriction requirement dated June 6, 2006, and further request reconsideration of the restriction requirement.

The Examiner restricted the invention as follows:

Group I	Claims 3-6 and claims 1-2, 7-13 and 47-51 (in part)	Drawn to compounds and compositions and processes for the manufacture of compounds of formula (I) wherein R is aryl
Group II	Claims 1-2, 7-13 and 47-51 (in part)	Drawn to compounds and compositions and processes for the manufacture of compounds of formula (II) [sic] wherein R is a heterocycle
Group III	Claims 41-43 and 52	Drawn to an assay for determining the activity of compounds
Group IV	Claims 16-23, 31-32 and 45-46	Drawn to a method of using compounds of formula (I)

Restriction is only proper if the restricted inventions are independent and patentably distinct and the search and examination of the entire application cannot be made without serious burden (MPEP 803). Applicants respectfully traverse the restriction requirement and submit that the restriction is improper. First, all pending claims involve a single inventive concept for which a single patent should issue, that is, they deal with the c-Jun N-terminal kinases inhibiting compounds of formula I, which are useful for the prevention and/or treatment of neurodegenerative disorders related to apoptosis and/or inflammation. Moreover, the inclusion of the assay for determining the activity and the method of use claims does not constitute any extra burden on the Examiner, because the claims involve the same structure of formula of I.

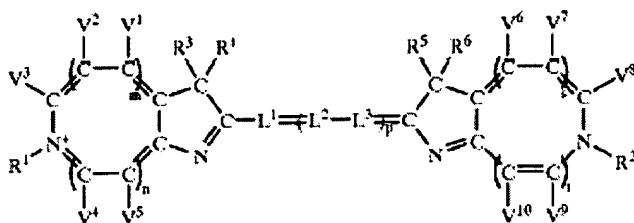
Additionally, Applicants respectfully disagree with the Examiner's statements that the "Markush alternative is not novel" and the pyrrolopyridine ring "does not make a contribution over the prior art" and reserve the right to submit appropriate remarks toward patentability during prosecution on merits.

III. Proposed Restriction Requirement

Applicants respectfully submit that Group I and Group II as identified by the Examiner are in unity and therefore should be combined. Group I relates to Claims 3-6 and claims 1-2, 7-13 and 47-51 (in part) relating to compounds and compositions and processes for the manufacture of compounds of formula (I) wherein R is aryl, while Group II relates to Claims 1-2, 7-13 and 47-51 (in part) relating to compounds and compositions and processes for the manufacture of compounds of formula (II) [sic] wherein R is a heterocycle. (This appears to be a typo and compounds of formula (II) should be compounds of formula (I).)

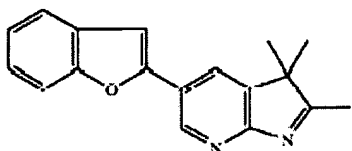
The Examiner considers that the compounds of formula (I) as claimed in claim 1 relate to two separate inventions, as the common feature of the compounds of formula (I), i.e. the pyrrolopyridine ring is not novel over the disclosure of a pyrrolopyridine compound linked to a benzofuran in U.S. Patent No. 6,642,375.

Applicants respectfully submit that the Examiner's conclusion is incorrect as shown below. U.S. Patent No. 6,642,375 relates to a fluorescent substance represented by the formula A-B-C wherein C is a compound having general formula (I) as illustrated below.



Rather than disclosing a 1H-pyrrolo[2,3-b]pyridine,5-(2-benzofuranyl) compound, as indicated by the Examiner, U.S. 6,642,375 instead discloses a compound of general formula (I) which can contain a benzofuranyl substituent, for example, at the V¹ or V² position. Such a compound does not fall within the scope of claim 1 of the present application.

Columns 35 and 36 of U.S. 6,642,375 disclose a compound 10a



as a starting material for the production of a compound of formula 10. Claim 1 of the present application does not encompass compounds having two substituents at C(3) or having a double bond between N(1) and C(2). This compound does not fall within formula (I) as set out in claim 1 of the present application.

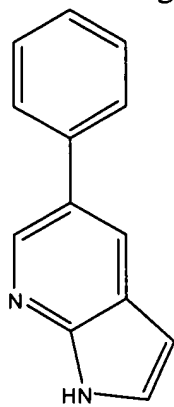
For the reasons given above, Applicants respectfully submit that the Examiner's conclusion regarding the novelty of the claims of the present application is incorrect. In particular, the claims of the present application are novel over US Patent No. 6,642,375. Therefore, Applicants request that Groups I and II be rejoined.

IV. Provisional Response to Restriction Requirement

Applicants provisionally elect Group I, claims 3-6 and claims 1-2, 7-13 and 47-51 (in part) relating to compounds and compositions and processes for the manufacture of compounds of formula (I) wherein R is aryl, with traverse.

V. Election of Species

In response to the election of species requirement, Applicants elect the compound having the following structure with traverse:



(i.e., a compound of formula (I), wherein R is phenyl).

VI. Conclusion

Applicants respectfully request that the restriction requirement be withdrawn and/or Applicant's proposed restriction requirement be allowed.

An early and favorable consideration and allowance of the pending claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Henry H. Gu', written in a cursive style.

Henry H. Gu
Registration No. 55,227

Dated: September 6, 2006
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109
Phone: (617) 526-6652